

YOUNG CONAWAY STARGATT & TAYLOR, LLP

JEFFREY T. CASTELLANO
DIRECT DIAL: 302-571-3587
DIRECT FAX: 302-576-3551
jcastellano@ycst.com

THE BRANDYWINE BUILDING
1000 WEST STREET, 17TH FLOOR
WILMINGTON, DELAWARE 19801

P.O. Box 391
WILMINGTON, DELAWARE 19899-0391

(302) 571-6600
(302) 571-1253 FAX
(800) 253-2234 (DE ONLY)
www.youngconaway.com

August 27, 2007

BY HAND DELIVERY

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The Honorable Mary Pat Thyng
United States District Court
844 North King Street
Wilmington, DE 19801

Re: Roquette Freres v. SPI Pharma, Inc., et al.
C.A. No. 06-540-***

Dear Magistrate Judge Thyng:

We respond to Roquette Freres's ("Roquette") letter to Your Honor dated August 24, 2007, summarizing Roquette's alleged discovery disputes against SPI Pharma, Inc. ("SPI"). Roquette identifies three specific issues that it asks Your Honor to address, two relating to mannitol products other than Mannogem™ EZ and the other concerning contention interrogatory responses. As shown below, SPI information related to "other mannitol products" is not relevant to Roquette's allegations of patent infringement in this case. Further, Roquette's request for contention responses is premature given the limited written discovery and document production provided by Roquette to date, and the absence as yet of any fact depositions.

Information Regarding SPI's Mannitol Products Other Than Mannogem™ EZ

Roquette identified only one allegedly infringing SPI product in its complaint, viz., Mannogem™ EZ. In the absence of a specific showing of relevance to infringement, Roquette is not entitled to conduct a "fishing expedition" for discovery concerning other SPI products. If Roquette believes that SPI sells another spray-dried mannitol product that infringes its U.S. Patent No. 5,573,777 ("the '777 patent"), it can obtain the product in the market place and test it just as Roquette allegedly did for the Mannogem™ EZ product. It is Roquette's burden to establish a good faith basis for its infringement allegations against SPI products. It is not SPI's burden to produce discovery based on Roquette's unsupported speculation that there may be other allegedly infringing products.

In any event, the most salient fact is that while SPI does market several mannitol products, only one of those products – Mannogem™ EZ – is a spray-dried mannitol. As Roquette is aware, SPI's entire commercial product list is available on SPI's website. See attached Exh. 1. Other than the EZ product, none of the other SPI products listed under the heading "Mannitol" is a spray-dried mannitol; thus, none are relevant to Roquette's claim of patent infringement. Roquette likely already knows as much because it has never identified any of those other products as allegedly infringing.

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SPI's Invalidity Contentions

SPI's responses to Roquette's contention interrogatories are more than adequate given the current early stage of fact discovery. At this juncture, SPI has served deposition notices, but has not yet had the opportunity to depose even a single fact witness. Moreover, as detailed in our August 24 letter, Roquette's document production to date and written discovery responses have been severely inadequate. SPI submits that it is entitled to further fact discovery from Roquette before it should be required to answer contention interrogatories. *See Fischer and Porter Co. v. Tolson*, 143 F.R.D. 93, 95 (E.D. Pa. 1992) ("[t]he interests of judicial economy and efficiency for the litigants dictate the 'contention interrogatories are more appropriate after a substantial amount of discovery has been conducted.'") (quoting *Nestle Foods Corp. v. Aetna Cas. and Sur. Co.*, 135 F.R.D. 101, 110-111 (D.N.J. 1990)); *In re Convergent Technologies Securities Litigation*, 108 F.R.D. 328, 338 (N.D. Cal. 1985) (courts are skeptical about the quality of the information that early responses to contention interrogatories are likely to contain).

Alternatively, if Roquette seeks immediate contention discovery, then Roquette, as plaintiff bearing the initial burden of proof, should first be required to answer SPI's Interrogatory Nos. 2, 7 and 12 requesting that Roquette explain in detail its infringement contentions. Roquette would thus identify which patent claims it contends are infringed and provide the factual and legal bases for its allegations, including an element-by-element claim chart specifying its infringement allegations. *S.S. White Burs, Inc. v. Neo-Flo, Inc.*, Civ. Action No. 02-3656, 2003 U.S. Dist. Lexis 7718, *4 (E.D. Pa. May 2, 2003) ("A plaintiff may be questioned as to which patent claims it contends are infringed....[C]ourts will postpone to the end of discovery the responses of 'contention interrogatories,' which ask a party to state all facts and theories upon which it bases a contention, so that the party does not have to articulate theories of its case which are not yet fully developed."). As is appropriate, SPI would then respond thirty

¹ For the record, SPI strongly disagrees with Roquette's overbroad characterization of its claimed invention as covering "mannitol that exhibits certain measured properties" (Roquette Aug. 24 Letter p. 1) or "mannitol products [that] result from spray drying" (*Id.* p. 2). On the contrary, Roquette's '777 patent claims are much narrower. They cover a pulverulent mannitol having a specific friability range, apparent density, particle size and rate of dissolution as measured by very specific assays. Moreover, Claim 23, the so-called process claim, covers a process for the preparation of pulverulent mannitol comprising "atomizing a mannitol fluid" and "granulating by a wet route the atomized mannitol fluid." Also, as noted above, the '777 patent specification expressly teaches that the pulverulent mannitol of the alleged invention is "relatively pure." (D.I. 1, Exh. A, col. 4, lines 51-54).

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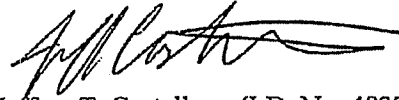
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days later with its contention interrogatory responses setting forth its explanation of the bases for patent invalidity.

For the foregoing reasons, and for any additional reasons offered at the teleconference before Your Honor tomorrow, this Court should deny Roquette's request for an Order compelling additional discovery from SPI.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Jeff Castellano', with a long horizontal flourish extending to the right.


Jeffrey T. Castellano (I.D. No. 4837)

JTC:mmeeh

Attachment

cc: Clerk, U.S. District Court (By Hand Delivery)
Mary B. Graham, Esquire (By Hand Delivery)
Julia Heaney, Esquire (By Hand Delivery)
Douglas V. Rigler, Esquire (By E-mail)

EXHIBIT 1



SPI Pharma™
Formulating Success Through Innovation

PRODUCTS

SPI Pharma™ Worldwide

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[Products](#)

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Please Read Products Disclaimer

Excipients & Carriers



Product Name

[Lubricant](#)

[Lubripharm® SSF](#)

[Effervescent Powder](#)

[Effer-Soda™](#)

[Fructose & Maltose Powders](#)

[Advantose™ 100](#)

[Advantose™ FS 95](#)

[Maltitol Solutions](#)

[Malto™ 5575](#)

[Malfo™ 7575](#)

[Mannitol](#)


[Mannogem™ Powder](#)

[Mannogem™ Powder](#)

[Mannogem™ Granular](#)

[Mannogem™ 2080](#)

Barcroft™ Antacid Actives



Product Name

[Formulated Products](#)

[Coblend Suspension](#)

[AMS 138 Al/Mg/Sorbitol Blend](#)

[DC Powders](#)

[AHMH 3535 Al/Mg/Premix](#)

[CS 90/ CS 90L Calcium Carbonate](#)

[MS 90/ MS 90L Magnesium Hydroxide](#)

[Simethicone SIM DC 100](#)

[BSP 95 Bismuth Subsalicylate](#)

[Standard Products](#)

[Aluminum Hydroxide Gels](#)

[Visco 9](#)


[Visco 10](#)

[LV 13](#)

[Hyper 10](#)

[Aluminum Hydroxide Powders](#)

Drug Delivery Systems



Product Name

[Delivery Platforms](#)

[Pharmaburst™ C1](#)

[Pharmagum™ S](#)

[Pharmagum™ C](#)

[Pharmagum™ M](#)

[Advantol™ 200](#)

[Drug Development Services](#)

[Pharmafreeze™](#)

[Pharmacaps™](#)

[Pharmaspertse™](#)

[Pharmasolutions™](#)

Additional Documentation

Click names below for product information.

Mannogem™ AG
 Mannogem™ EZ
 Compresol® S
 Sorbitol
 Sorbitab™ SD 250
 Sorbitab™ SD 500
 Liquid Sorbitol
 Sorbitol Special™
 Sorbitol 70%
 Sorbitol NC

USP 331
 0200
 0250
 0300
 0325

Magnesium Hydroxide Pastes
 Type M (standard)
 Paste LVM
 Flugel
 Flugel 16
 VLV
 VLV CG

Magnesium Hydroxide Powders
 5100 CG
 5200M
 5300D
 5110
 5111
 5112
 MS 90/MS 90L Magnesium Hydroxide

Specialty Products
 Magaldrate Gel
 Magaldrate Powder
 AHMC
 Boehmite NLP 14 (Gel)
 Aluminum Phosphate
 Vaccine Support
 VAC 15
 VAC 30

